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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,139	06/03/2004	Jessica R. DesNoyer	50623.326	2159

EXAMINER	
ROGERS, JAMES WILLIAM	

ART UNIT	PAPER NUMBER
1618	

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Squire, Sanders & Dempsey, L.L.P.
Suite 300
1 Maritime Plaza
San Francisco, CA 94111

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/750,139	Applicant(s) DESNOYER ET AL.	
	Examiner James W. Rogers, Ph.D.	Art Unit 1618	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 07 January 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Continuation of 11. does NOT place the application in condition for allowance because: applicants remarks on the rejections under 35 U.S.C 103(a) over Roby et al. (WO 98/32398 A1) in view of Pinhcuck et al. (US 2002/0107330) and over Pacetti (WO 03/022323 A1) and in view of Roby et al. (WO 98/32398 A1) are not persuasive.

Applicants firstly assert that Roby does not disclose a method of forming a coating comprising applying to an implantable device a composition that comprises a PEA polymer and a low surface energy, surface blooming polymer that includes a PEA miscible block or PEA miscible backbone. Applicant also assert that neither Roby nor Pinhcuck recognize the need to improve the properties of a coating formed of a PEA polymer using a low surface energy, surface blooming polymer. Applicants assert that Pinhcuck does not describe or teach a polymer blend to form a coating nor does the reference recognize the need to improve the properties of the coating. Applicants therefore surmise that there is no motivation for a person of ordinary skill to combine the references nor is there a reasonable expectation of success.

The relevance of these assertions is unclear. Firstly teaching, suggestion or motivation are not the only considerations when determining whether two or more references can be combined, as detailed in the recent decision of KSR International Co. v. Teleflex Inc. (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Clearly the combination of references would yield a coating for a medical device comprising the PEA polymer of Roby and the biocompatible A-B block copolymer of Pinhcuck that is the same as applicants claimed low surface energy polymer of claim 4. It is generally considered to be *prima facie* obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. Clearly one of ordinary skill in the art could envision that since the polymers described were both useful for the same purpose one would expect that they could be combined and yield predictable results.

Applicants secondly assert that Pacetti does not disclose PEA as pointed out by the examiner nor do the Pacetti and Roby references disclose a coating applied to an implantable device comprising a low surface energy, surface blooming polymer that includes a PEA miscible block or PEA miscible backbone. Applicant also assert that neither Pacetti nor Roby recognize the need to improve the properties of a coating formed of a PEA polymer using a low surface energy, surface blooming polymer. Applicants also seem to imply that since polyurethane was deleted from the claims (examiner notes only claim 4 made this deletion) polyurethane with a polydimethylsiloxanes soft segment would not longer read on their claims. Thus applicants surmise that the combination of references do not teach all of the claimed elements within independent claims 1,8,12,19,23 and 30.

The relevance of these assertions is unclear. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Since by combination the two references disclose the same type of polymers and the same type of polymer additives the claim limitation is obviously met because the same compounds will have the same miscibility properties. Roby discloses PEA polymers in coating surgical devices while Pacetti discloses polyurethanes with a polydimethylsiloxane soft segment useful in coating stents. From applicants own specification polyurethanes with a polydimethylsiloxane soft segment would meet a low surface energy surface blooming polymer or polymer additive that includes a miscible PEA block or backbone. See page 3 line 15-page 4 line 14 of applicants specification. Regarding applicant's assertion that polyurethane was deleted from the claims, this has no bearing on the claims rejected by Pacetti and Roby, the only claim that included this limitation was claim 4 which was not rejected over the references above. Since the claims rejected over Pacetti and Roby do not exclude a polymer that contains polyurethane with a polydimethyl soft segment it would still read on applicants claims because as described above such a polymer would meet a low surface energy surface blooming polymer or polymer additive. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.


MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER